REMARKS

The last Office Action dated **10/02/96** has been carefully considered.

Claims 1-3, 8, 14, and 20-27 are rejected under *35 U.S.C.* § *103* as being unpatentable over **Wetzel** (U.S. Patent #3,041,748) in view of **Kershaw** (U.S. Patent #3,019,742). The present invention by **Lucky** is designed to incorporate numerous features which combine to make it more effective for use in the specific applications for which it is intended. It is much more likely to be accepted and adapted for use by the public for this purpose, and as such, will more readily benefit the public. Simply stated, the present invention by **Lucky** is compellingly useful in furthering the public interest. Specifically, the **Wetzel** patent is inferior to the present invention due to the following features:

Examination of the **Wetzel** patent reveals a plethora of functional limitations which include but are not limited to the following:

The **Wetzel** patent claims a comprehensively different system than does the **Lucky** invention. The **Wetzel** patent is specifically designed as an apparatus for removing snow comprising a vehicle adapted to travel along the ground, a jet engine having a discharge conduit through which the engine blast is discharged at high velocity, the engine is mounted on the vehicle so that its

blast discharges in the direction towards which the vehicle travels; and a duct, having an inlet and an outlet, mounted on the vehicle with its inlet adjacent the discharge conduit of the engine, the internal cross-sectional areas of the duct from 1.5 to 2.5 times the internal cross-sectional area of the discharge conduit of the engine, whereby ambient air is brought through the duct by the blast discharging from the engine, to increase the mass flow of gases discharging from the duct. While it is applicable for this specific but limited use, the **Wetzel** patent as a whole constitutes a wholly different aspect of the complete **Lucky** invention.

The patent by **Wetzel** is inferior in that it does not take advantage of the embodiment present in the **Lucky** invention. The **Lucky** invention discloses a snow and ice melting device comprising a road transport vehicle and a railroad track transport vehicle mounted on a common road transport vehicle chassis. Upon the railroad track transport vehicle, a melter is mounted on a melter rotator functioning to rotate the melter from a rearward (road transport vehicle frontward) direction from which it can be utilized as a propulsion means in addition to its snow and ice melting and removal function, to a frontward (road transport vehicle rearward) direction which is utilized for melting snow and/or ice. The melter has a melter lift such that a user can angle the melter to a desired position.

The **Wetzel** patent differs from the present invention because the **Wetzel** patent fails to disclose a melter movably mounted on the railroad track transport vehicle, wherein the melter comprises a melter housing within which a melter heat generating means having a melter heat generating means air intake is securely positioned, a melter rotator mounted on the road transport vehicle chassis and hydraulically coupled to the railroad track transport vehicle hydraulic means clockwise/counterclockwise converter, and a melter lift mounted on the meter rotator and hydraulically coupled to the railroad track transport vehicle hydraulic means. Furthermore, the cited reference fails to disclose wheels shrouded within the housing. Nor does the **Wetzel** patent describe the use of a nozzle connected to the melter by a connecting bracket means consisting of a nozzle front connecting bracket, which is securely attached to the nozzle, and a nozzle rear connecting bracket, which is securely fastened to the melter. In the present invention, the nozzle front connecting bracket is securely fastened to the nozzle rear connecting bracket by a plurality of nozzle connecting bracket fins. Therefore, even though this innovation may be suitable for the specific individual purposes to which it addresses, it would not be suitable for the purposes of the present invention as heretofore described.

As a result, the **Lucky** invention provides a much higher degree of overall utility than does the **Wetzel** patent, and will appeal to the vast amount of consumers who will want the benefits of a snow and ice melting device which is mounted on a vehicle having road wheels for road transportation and track

wheels for railroad track transportation. The limitations of the **Wetzel** patent will decrease the likelihood of widespread public usage for the **Wetzel** patent and conversely, increase the likelihood of widespread public usage for the **Lucky** invention.

Claims 1-3, 8, 14, and 20-27 are rejected under *35 U.S.C.* § *103* as being unpatentable over **Wetzel** (U.S. Patent #3,041,748) in view of **Kershaw** (U.S. Patent #3,019,742).

The present invention by **Lucky** is designed to incorporate numerous features which combine to make it more effective for use in the specific applications for which it is intended. It is much more likely to be accepted and adapted for use by the public for this purpose, and as such, will more readily benefit the public. Simply stated, the present invention by **Lucky** is compellingly useful in furthering the public interest. Specifically, the **Kershaw** patent is inferior to the present invention due to the following features:

Examination of the **Kershaw** patent reveals a plethora of functional limitations which include but are not limited to the following:

The **Kershaw** patent claims a comprehensively different system than does the current invention. The **Kershaw** patent is specifically designed to act as a construction and maintenance unit for railways including a chassis with power

plant mounted thereupon, roadway and railway wheels engageable with each other, a hydraulic means from a prime mover driven for incrementally selectively adjusting the heights of each railway wheel from each roadway wheel, and a second hydraulic means for retaining the railway wheels for propelling the chassis along the rails. While it is applicable for this specific but limited use, the patent as a whole constitutes a wholly different aspect of the complete **Lucky** invention.

The patent by **Kershaw** is inferior in that it does not take advantage of the embodiment present in the **Lucky** invention. The **Lucky** invention discloses a snow and ice melting device comprising a road transport vehicle and a railroad track transport vehicle mounted on a common road transport vehicle chassis. Upon the railroad track transport vehicle, a melter is mounted on a melter rotator functioning to rotate the melter from a rearward (road transport vehicle frontward) direction from which it can be utilized as a propulsion means in addition to its snow and ice melting and removal function, to a frontward (road transport vehicle rearward) direction which is utilized for melting snow and/or ice. The melter has a melter lift such that a user can angle the melter to a desired position.

The **Kershaw** patent differs from the present invention because the **Kershaw** patent fails to disclose wheels shrouded within the housing. Nor does the **Kershaw** patent describe the use of a nozzle connected to the melter by a

connecting bracket means consisting of a nozzle front connecting bracket, which is securely attached to the nozzle, and a nozzle rear connecting bracket, which is securely fastened to the melter. In the present invention, the nozzle front connecting bracket is securely fastened to the nozzle rear connecting bracket by a plurality of nozzle connecting bracket fins.

It would not have been obvious to incorporate the versatility of the invention by **Kershaw** into the apparatus described in the **Wetzel** patent. Although the patent by **Kershaw** is evidence that some vehicles, namely locomotives, have the ability to convert from road to rail, the cited references and the prior art in general show no such means as applied to snow or ice removal devices or other rail maintenance devices. That the conversion locomotive of the **Kershaw** patent displays some form of converting from road to rail usage should not be a bar to patentability here, where the present invention incorporates numerous additional features not found in the cited references, as stated in the independent claim as amended herein. Specifically, the **Kershaw** patent fails to claim as effective a rail traveling means as the invention herein, which utilizes a right front wheel stanchion, railroad track transport vehicle left front wheel stanchion, railroad track transport vehicle left rear wheel stanchion , and railroad track transport vehicle right rear wheel stanchion with sufficient height to provide turning capability for the snow and ice melting device to negotiate around a curve in the railroad track. Therefore, even though the **Kershaw** innovation may be suitable for the specific individual

purposes to which it addresses, it would not be suitable for the purposes of the present invention as heretofore described.

As a result, the **Lucky** invention provides a much higher degree of overall utility than does the **Kershaw** patent, and will appeal to the vast amount of consumers who will want the benefits of a snow and ice melting device which is mounted on a vehicle having road wheels for road transportation and track wheels for railroad track transportation. The limitations of the **Kershaw** patent will decrease the likelihood of widespread public usage for the **Kershaw** patent and conversely, increase the likelihood of widespread public usage for the **Lucky** invention.

Claims 10-12 and 16-18 are rejected under *35 U.S.C.* § *103* as being unpatentable over **Wetzel** (U.S. Patent #3,041,748) in view of **Kershaw** (U.S. Patent #3,019,742) and further in view of **Gasser** (U.S. Patent # 3,866,539). The present invention by **Lucky** is designed to incorporate numerous features which combine to make it more effective for use in the specific applications for which it is intended. It is much more likely to be accepted and adapted for use by the public for this purpose, and as such, will more readily benefit the public. Simply stated, the present invention by **Lucky** is compellingly useful in furthering the public interest. Specifically, the **Gasser** patent is inferior to the present invention due to the following features:

Examination of the **Gasser** patent reveals a plethora of functional limitations which include but are not limited to the following:

The **Gasser** patent claims a comprehensively different system than does the **Lucky** invention. The **Gasser** patent is specifically designed as a wheel guard and travel stop arrangement for a car washing device or the like. A guard wiper at each of the four corners of the carriage cooperates with a respective track to wipe it clean. The guard wipers cooperate with minimum profile travel stops to limit carriage travel. While it is applicable for this specific but limited use, the **Gasser** patent as a whole constitutes a wholly different aspect of the complete **Lucky** invention.

The patent by **Gasser** is inferior in that it does not take advantage of the embodiment present in the **Lucky** invention. The **Lucky** invention discloses a snow and ice melting device comprising a road transport vehicle and a railroad track transport vehicle mounted on a common road transport vehicle chassis. Upon the railroad track transport vehicle, a melter is mounted on a melter rotator functioning to rotate the melter from a rearward (road transport vehicle frontward) direction from which it may be utilized as a propulsion means in addition to its snow and ice melting and removal function to a frontward (road transport vehicle rearward) direction which is utilized for melting snow and/or ice. The melter has a melter lift such that a user can angle the melter to a desired position.

The **Gasser** patent differs from the present invention because the **Gasser** patent does not describe the use of a railroad track transport vehicle left rear wheel outer-inner housing connecting plate which has a railroad track transport vehicle left rear wheel outer-inner housing connecting plate bracket mounted thereon, as well as a railroad track transport vehicle right rear wheel outer-inner housing connecting plate has a railroad track transport vehicle right rear wheel outer-inner housing connecting plate bracket mounted thereon. That the **Gasser** patent includes the use of wheels shrouded within a housing should not be a bar to patentability here, where the present invention incorporates numerous additional features not found in the cited references, as stated in the independent claim as amended herein. Moreover, as mentioned with regards to the patent by **Kershaw**, the **Gasser** patent fails to claim as effective a rail traveling means as the invention herein, which utilizes a right front wheel stanchion, railroad track transport vehicle left front wheel stanchion, railroad track transport vehicle left rear wheel stanchion , and railroad track transport vehicle right rear wheel stanchion with sufficient height to provide turning capability for the snow and ice melting device to negotiate around a curve in the railroad track. Therefore, even though the **Gasser** innovation may be suitable for the specific individual purposes to which it addresses, it also would not be suitable for the purposes of the present invention as heretofore described.

As a result, the **Lucky** invention provides a much higher degree of overall utility than does the **Gasser** patent, and will appeal to the vast amount of consumers who will want the benefits of a snow and ice melting device which is mounted on a vehicle having road wheels for road transportation and track wheels for railroad track transportation. The limitations of the **Gasser** patent will decrease the likelihood of widespread public usage for the **Gasser** patent and conversely, increase the likelihood of widespread public usage for the **Lucky** invention.

Hence the present invention as a whole would **NOT** have been an obvious matter of design choice to a skilled artisan at the time of the invention, since, applicant **HAS** disclosed that his invention **WOULD** solve a particular problem of being able to be applied to a **snow and ice melting device**. The patents of **Wetzel** and **Kershaw** could not be utilized singularly and/or in combination as the present invention can be utilized to be applied to an **snow and ice melting device**.

As for the proposed combination of references, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of Applicant's invention as defined now in the amended claims, any hypothetical construction produced by this combination would not lead to Applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

There is nothing in the cited art to suggest what Applicant did. In fact, these references do not even contain any suggestion that they could be combined in the manner proposed by the Examiner. However, this is a prerequisite for a combination rejection, as stated by the Patent Office Board of Appeals in its decision in *Ex Walker, 135 USPQ 195:*

> *"In order to justify combination of references it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so."*

The Court of Customs and Patent Appeals subscribed to the Board's reasoning, when it handed down its decision in the case *In re Imperato, 179 USPQ 730, holding:*

> *"The fact that the disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest the desirability of such a combination.*

"With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references."

In fact the art must not only be combinable in accordance with the principles of the above decisions, but to support a valid combination rejection the art must also suggest that the combination would accomplish Applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38)*, as follows:

"Claims are not rejected on the grounds that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modefying prior art devices."

It is also well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. Note would be taken in this connection of the decision of the Court of Customs and Patent Appeals *In re Kamm and Young, 17 USPQ 298 ff,* which appears most pertinent to the issues at hand and wherein the claims were also rejected over a combination of references. The Court held that:

> *"The rejection here runs afoul of a basic mandate inherent in section 103 - that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965)."* Emphasis added.

The mere fact that an invention is simple but accomplishes a genuine improvement is not sufficient reason to deny it patent protection.

In Schnell et al v. The Allbright-Nell Co. et al, 146 USPQ 322, the U.S. Court of Customs and Patent Appeals held that:

> *"Device seems simple and obvious in light of patentee's teaching, but it evidently was not obvious at time of invention; those working in the field did not accomplish patentee's results; that fact supports conclusion that patentee achieved patentable invention."* Emphasis added

The Board of Appeals expressed the same concept when it held, in *Ex parte Grasenick and Gessner, 158 USPQ 624,* that

> *"Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious."*

Attention is also directed to *Mercantile National Bank of Chicago et al v. Quest, Inc. et al. D.C., N.D., Indiana, 166 USPQ 517, In re Shelby, 136 USPQ 220, and In re Irani and Moedritzer, 166 USPQ 24,* which all indicate that simplicity does not operate as a bar to patentability, if the invention was unobvious at the time it was made.

It is respectfully submitted that when the rejection of the claims is reviewed in light of Applicants' arguments, the invention without a doubt should be considered patentably distinguished over the currently applied references.

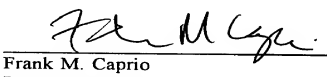
In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the amended claims and should be withdrawn.

Claims 29-54 should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

RESPECTFULLY SUBMITTED,



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